

Attorney Docket: 030552
U.S. Application 10/673,949 Examiner Ramakrishnaiah
Response to September 9, 2007 Final Office Action

REMARKS

In response to the final Office Action dated September 12, 2007, the Assignee respectfully requests reconsideration and removal of the final rejection of the pending claims. As the following paragraphs explain, any proposed combination involving *Kredo* with *O'Brien* "teaches away" and cannot support a *prima facie* case for obviousness.

Claims 1-9 and 13-18 are pending in this application. Claims 10-12 were previously canceled without prejudice or disclaimer.

***Kredo* with *O'Brien* "Teaches Away"**

Claims 1, 3-5, 7-9, 13, and 15-18 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,714,637 to *Kredo* in view of U.S. Patent 4,893,329 to *O'Brien*. Claim 2 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Kredo* in view of *O'Brien* and further in view of U.S. Patent 6,700,957 to *Horne*. Claim 6 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Kredo* in view of *O'Brien* and further in view of U.S. Patent 6,968,216 to *Chen, et al.*

Kredo with *O'Brien*, however, "teaches away" from the pending claims. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

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The Examiner's *prima facie* cases all require impermissible changes to either Kredo's or O'Brien's principles of operation. Examiner Ramakrishnaiah proposes to combine Kredo's customized call waiting indicators with O'Brien's device for deferring incoming calls. This proposed combination, however, requires impermissible changes to Kredo's or O'Brien's principles of operation. When O'Brien defers an incoming call, O'Brien "seizes the telephone line" and the incoming call "will not be completed" to the called party. That is, O'Brien's device for deferring incoming calls would not allow for Kredo's customized call waiting indicators. The proposed combination of Kredo with O'Brien, then, would never permit "receiving a first incoming communication" and "producing a first initial alert of the first incoming communication," as the independent claims recite. The proposed combination of Kredo with O'Brien would also never permit "receiving a second incoming communication during the period of time of suppression" and "producing a second initial alert of the second incoming communication," as the independent claims recite. As Kredo's or O'Brien's principle of operation must be impermissibly changed, the *prima facie* cases for obviousness must fail.

Kredo and O'Brien explain their principles of operation. Kredo discloses customized call waiting indicators, such as custom audio files, tones, and text that are associated to calling phone numbers. See U.S. Patent 6,714,637 to Kredo at column 2, lines 35-45. See also *id.* at column 2, lines 60-65 and at column 4, lines 1-10. O'Brien describes a device that defers incoming telephone calls so as not to disturb the called party. See U.S. Patent 4,893,329 to O'Brien at column 1, lines 6-13. "In the defer mode of operation, the device detects a valid ring signal, suppresses the telephone ringers, seizes the telephone line and transmits to the calling party a ... voice message." *Id.* at column 2, lines 6-10 (emphasis added). "While the subscriber line is in the defer mode, calls placed to it will not be completed but will instead be intercepted at the central office." *Id.* at column 10, lines 41-43 (emphasis added). "The calling party will be given a voice message ... that the called party is not accepting calls." *Id.* at column 10, lines 44-46 (emphasis added). Local and long distance calls are not completed when in the defer mode of operation. See *id.* at column 10, lines 55-58.

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Kredo with *O'Brien*, then, "teaches away" from the pending claims. If *Kredo* is combined with *O'Brien*, as the Office proposes, then *Kredo's* entire teaching (e.g., customized call waiting indicators) must be eliminated. Or, *O'Brien's* principle of operation must be changed to not play a voice message and to, instead, allow incomings calls to be completed. Because the patent laws forbid changing a principle of operation to support a *prima facie* case, the proposed combination of *Kredo* with *O'Brien* cannot support a *prima facie* case for obviousness. All the *prima facie* cases for obviousness must fail, so the Office is respectfully requested to remove the § 103 rejections of the pending claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390